UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/087,516	ROTH ET AL.
	Examiner	Art Unit	
	Etienne P LeRoux	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 December 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1, 2, 5-21 and 23-27</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1, 2, 5-21 and 23-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>01 March 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
             application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Status of the Claims

Claims 1, 2 and 5-21 and 23-27 are pending; claims 3, 4 and 22 have been canceled.

Claims 1, 2 and 5-21 and 23-27 are rejected as detailed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5-15 and 18-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pub No 2003/0131355 issued to Berenson et al (hereafter Berenson) in view of

US Pat No 5,828,419 issued to Bruette et al (hereafter Bruette).

Claims 1, 5 and 19:

Berenson discloses:

receiving a request from a user to generate a recommendation guide [paragraph 23]

retrieving category preferences associated with the user [paragraph 39]

retrieving a list of preferred program indicators, wherein the preferred program indicators correspond to programs of interest selected by the user [Fig 1 and paragraphs 32-39]

retrieving a list of recommended program indicators [paragraph 83] the program indicators included in the list of recommended program indicators corresponding to at least one of the retrieved category preferences, wherein the recommended program indicators correspond to programs recommended to the user by a third party;

generating a list of displayable program indicators [Figs 7-9] wherein the list of displayable program indicators includes program indicators included in the list of preferred program indicators and program indicators included in the list of recommended program indicators but not included in the list of restricted program indicators [paragraph 42]

displaying program indicators included in the generated list of displayable program indicators, wherein the displayed program indicators are arranged according to the retrieved category preferences [Figs 7-9, paragraph 63].

Berenson discloses the essential elements of the claimed invention as noted above but fails to disclose retrieving a list of restricted program indicators. Bruette discloses retrieving a list of restricted program indicators [col 4, lines 57-65]. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify Berenson to include retrieving a list

of restricted program indicators as taught by Bruette for the purpose of excluding certain

programs from the guide [col 4, lines 57-60]. The skilled artisan would have been motivated to

modify Berenson per the above such that children are not able to view adult programs.

Claim 2:

The combination of Berenson and Bruette disclose the elements of claim 1 as noted

above and fu8rthermore, Berenson discloses transmitting the generated list of displayable

program indicators to a set-top box associated with the user [paragraph 37]

Claim 6:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted

above and furthermore, Berenson discloses displaying the retrieved program data for a first

program indicator included in the list of displayable program indicators, wherein the retrieved

program data for the first program indicator is displayed in association with a first category

included in the plurality of category preferences, wherein the first category corresponds with the

first program indicator [category 1, Fig 7]

Claim 7:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted

above and furthermore, Berenson discloses displaying the retrieved program data for a second

program indicator included in the list of displayable program indicators, wherein the retrieved

program data for the second program indicator is displayed in association with a first category

included in the plurality of category preferences, wherein the second category corresponds with

the second program indicator [category 2, Fig 7].

Claim 8:

The combination of Berenson and Bruette discloses the elements of claims 5-7 as noted

above and furthermore, Berenson discloses displaying the first program indicator and an

indicator of the first category in a row; and displaying the second program indicator and an

indicator of the second category in a second row, however, Berenson does not disclose

displaying the first program indicator and an indicator of the first category in a first column; and

displaying the second program indicator and an indicator of the second category in a second

column. It would have been obvious tone of ordinary skill in the art at the time the invention

was made to modify the above combination of references to include displaying the first program

indicator and an indicator of the first category in a first column; and displaying the second

program indicator and an indicator of the second category in a second column for the purpose of

placing the time axis in the first column. The skilled artisan would have been motivated to

modify the above combination of references per the above such that the program guide

prominently discloses program time and thus makes the program more easy to read.

Claim 9:

The combination of Berenson and Bruette discloses the elements of claims 5-7 as noted

above and furthermore, Berenson discloses displaying the first program indicator and an

indicator of the first category in a first row, and displaying the second program indicator and an

indicator of the second category in a second row [Fig 7]

Claim 10:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore, Berenson discloses a list of recommended programs, wherein the list of recommended programs corresponds to programs recommended to the user by a third party [Fig 7, category 6, paragraph 83]

Claim 11:

The combination of Berenson and Bruette discloses the elements of claims 5 and 10 as noted above and furthermore, Berenson discloses receiving the list of recommended programs from a remote source [Fig 1, paragraph 33]

Claim 12:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore Bruette discloses identifying a restricted program indicator, the restricted program indicator being selectable by the user; wherein the list of displayable program indicators does not include the restricted program indicator [col 4, lines 57-65]

Claim 13:

The combination of Berenson and Bruette discloses the elements of claims 5 and 12 as noted above and furthermore Bruette discloses removing the restricted program indicator from the list of displayable programs [col 4, lines 57-65].

Claim 14:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore Berenson discloses identifying a preferred program indicator, the preferred program indicator being selectable by the user, and the preferred program indicator corresponding to a program of interest selected by the user, wherein the list of displayable program indicators includes the preferred program indicator [Fig 1 and paragraphs 32-39]

Claim 15:

The combination of Berenson and Bruette discloses the elements of claims 5 and 14 as noted above and furthermore Berenson discloses adding the preferred program indicator to the list of displayable programs indicators [Fig 1 and paragraphs 32-39]

Claim 18:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore, Berenson discloses wherein the plurality of category preferences are customizable by the user [paragraph 39].

Claim 20:

The combination of Berenson and Bruette discloses the elements of claim 19 as noted above and furthermore, Berenson discloses a list of recommended programs, wherein the list of recommended programs corresponds to programs recommended to the user by a third party [Fig 7, category 6, paragraph 83]

Claim 21:

The combination of Berenson and Bruette discloses the elements of claims 19 and 20 as
noted above and furthermore, Berenson discloses receiving the list of recommended programs
from a remote source [Fig 1, paragraph 33]

Claim 23:

The combination of Berenson and Bruette discloses the elements of claims 19-21 as
noted above and furthermore Bruette discloses removing the restricted program indicator from
the list of displayable programs [col 4, lines 57-65].

Claim 24:

The combination of Berenson and Bruette discloses the elements of claims 19-22 as
noted above and furthermore Berenson discloses identifying a preferred program indicator, the
preferred program indicator being selectable by the user, and the preferred program indicator
corresponding to a program of interest selected by the user, wherein the list of displayable
program indicators includes the preferred program indicator [Fig 1 and paragraphs 32-39]

Claim 25:

The combination of Berenson and Bruette discloses the elements of claims 19-22 and 24
as noted above and furthermore Berenson discloses adding the preferred program indicator to the
list of displayable programs indicators [Fig 1 and paragraphs 32-39]

Claims 16, 17, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

the combination of Berenson and Bruette an further in view of Pub No US 2002/0110353 issued

to Potrebic et al (hereafter Potrebic).

Claim 16:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted

above but fails to disclose identifying a previously viewed program, the previously viewed

program being associated with a target program indicator; locating the target program indicator

in the list of displayable program indicators; and removing the target program indicator from the

list of displayable program indicators. Potrebic discloses determining whether or not to delete

the viewed portion [paragraph 77]. It would have been obvious to one of ordinary skill in the art

at the time the invention was made to further modify the combination of Berenson, Bruette and

Potrebic to include identifying a previously viewed program, the previously viewed program

being associated with a target program indicator; locating the target program indicator in the list

of displayable program indicators; and removing the target program indicator from the list of

displayable program indicators for the purpose of deleting a program which the user has already

viewed. The skilled artisan would have been motivated to modify the above combination of

references such that the viewer is spared the frustration of losing a time slot because the time slot

has been assigned to a previously viewed program which is of no interest to the viewer.

Claim 17:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted

above but fails to disclose identifying a previously viewed program, the previously viewed

program being associated with a target program indicator; locating the target program indicator

in the list of displayable program indicators; and assigning a low display priority to the target

program indicator included in list of displayable program indicators. Potrebic discloses

determining whether or not to delete the viewed portion [paragraph 77]. It would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify the

combi9nation of Berenson, Bruette and Potrebic to include identifying a previously viewed

program, the previously viewed program being associated with a target program indicator;

locating the target program indicator in the list of displayable program indicators; and assigning

a low display priority to the target program indicator included in list of displayable program

indicators for the purpose of assigning a low priority to a program which the user has already

viewed. The skilled artisan would have been motivated to modify the above combination of

references such that the viewer is given the choice of once again viewing a previously viewed

program in the event the viewer wants to see the program again because the viewer highly

enjoyed the first viewing.

Claim 26:

The combination of Berenson and Bruette discloses the elements of claims 19-22 and 24

as noted above but fails to disclose identifying a previously viewed program, the previously

viewed program being associated with a target program indicator; locating the target program

indicator in the list of displayable program indicators; and removing the target program indicator

from the list of displayable program indicators. Potrebic discloses determining whether or not to

delete the viewed portion [paragraph 77]. It would have been obvious to one of ordinary skill in

the art at the time the invention was made to further modify the combination of Berenson,

Bruette and Potrebic to include identifying a previously viewed program, the previously viewed

program being associated with a target program indicator; locating the target program indicator

in the list of displayable program indicators; and removing the target program indicator from the

list of displayable program indicators for the purpose of deleting a program which the user has

already viewed. The skilled artisan would have been motivated to modify the above

combination of references such that the viewer is spared the frustration of losing a time slot

because the time slot has been assigned to a previously viewed program which is of no interest to

the viewer.

Claim 27:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted

above but fails to disclose identifying a previously viewed program, the previously viewed

program being associated with a target program indicator; locating the target program indicator

in the list of displayable program indicators; and assigning a low display priority to the target

program indicator included in list of displayable program indicators. Potrebic discloses

determining whether or not to delete the viewed portion [paragraph 77]. It would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify the

combi9nation of Berenson, Bruette and Potrebic to include identifying a previously viewed

program, the previously viewed program being associated with a target program indicator;

locating the target program indicator in the list of displayable program indicators; and assigning

a low display priority to the target program indicator included in list of displayable program

indicators for the purpose of assigning a low priority to a program which the user has already

viewed. The skilled artisan would have been motivated to modify the above combination of

references such that the viewer is given the choice of once again viewing a previously viewed

program in the event the viewer wants to see the program again because the viewer highly

enjoyed the first viewing.

Response to Arguments

Applicant's arguments filed 12/8/2005 have been fully considered and not found

persuasive for the reasons given below.

Applicant Argues:

Applicant states in the following in the third paragraph of page 1:

Relative to claim 1, although applicants do agree with the Office Action – in so far as the Office

Action recognizes that Berenson fails to disclose "retrieving a list of restricted program

indicators" -- Applicants disagree that Berenson teaches "generating a list of displayable

program indicators" that does not include program indicators "in the list of restricted program

indicators." Specifically, the recited "list of displayable program indicators" is generated so as to

exclude "the list of restricted program indicators. Applicants submit that because Berenson does

not teach a "list of restricted program indicators " it cannot exclude "the list of restricted program

indicators" fro the "displayable program indicators" as recited in independent claim 1.

Examiner Responds:

Examiner is not persuaded. In response to applicant's arguments against the references

individually, one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, Berenson discloses channels which are eliminated from the recommended channels because a user has explicitly designated such channels as "do not show me" (paragraph 39). At the time of the invention, one of ordinary skill in the art would have been motivated to combine a "list of recommended program indicators" as taught by Berenson with a list of "restricted program indicators" as taught by Bruette [col 4, lines 50-65] because restricted programs are obviously not a recommended programs and thus restricted programs should not be included in the list of recommended programs.

Applicant Argues:

Applicant states in the second paragraph of page 11 "as a consequence, neither Bruette not Berenson teach the recited "generating a list of displayable program indicators which excludes program indicators from the 'list of restricted program indicators.'"

Examiner Responds:

Examiner is not persuaded. Bruette discloses the following:

column 4, lines 57-65:

More specifically, when commanded to generate the program guide, microprocessor 15 reviews all programs to be included in the guide. If any of the programs are restricted under either of the foregoing methods, the microprocessor 15 generates a "lock" icon 50 and functions to display the icon adjacent any restricted program, as shown in FIG. 3. The "lock" icon is stored as part of the aforementioned font table, and is recalled by the microprocessor 15 as required. The microprocessor 15 combines the data representing the icon with the program information associated with the restricted program, and then converts the combined data into displayable graphics data. As stated above, the displayable graphics data is then coupled to the MPEG chip 22 and subsequently displayed

Bruette inherently discloses a "list of restricted program indicators" because Bruette discloses that microprocessor 15 reviews all programs to be included in the guide. If any of the

programs are restricted under either of the foregoing methods, the microprocessor 15 generates a

'lock' icon 15 and functions to display the icon adjacent any restricted program as shown in

Figure 3. In order to display the lock icon 15 against a program, the microprocessor must have a

list of restricted program indicators.

Applicant Argues:

Applicant states in the third paragraph of page 11

Finally, Applicants submit Bruette actually teaches away from "displayable program indicators"

that do not include indicators "in the list of restricted program indicators." Specifically, Bruette

teaches that it is advantageous to display their restricted programs along with unrestricted

programs (as depicted in Figs 2 and 3 of Bruette).

Bruette, Col 5, lines 38-45

Most importantly, in the exemplary embodiment described above, the present invention allows

the viewer to readily and easily identify if a program or channel has been restricted from

viewing. As a result, the viewer has ready access to all available programs, and can modify the

restricted list if he/she desires to view a restricted program

Examiner Responds:

Examiner is not persuaded. Examiner wishes to thank applicant for the above reference

wherein Bruette clearly discloses a list of restricted programs. Applicant obviously has answered

Applicant's previous comment that Bruette does not disclose a "list of restricted program

indicators." Furthermore, examiner is confused by Applicant's assertion that Bruette teaches

away from the claimed invention because Bruette specifically discloses that the "restricted

program indicators" are **not** (emphasis added) included in the "list of recommended program

indicators" because the user can readily and easily identify a recommended program or channel and a restricted program or channel.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. .

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

2/1/2006